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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,386	12/28/1999	MARIO GUILLEN	BAL6019P0090	9922

32116 7590 09/24/2002

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
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EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
1661	24

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/473,386	GUILLEN, MARIO
	Examiner	Art Unit
	June Hwu	1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 August 2002.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 25 is/are allowed.
- 6) Claim(s) 13-24 and 26-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

#### DETAILED ACTION

The terminal disclaimer and amendment filed August 26, 2002 have been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

#### *Terminal Disclaimer*

The terminal disclaimer filed on August 26, 2002 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of Plant Patent No. 12,588 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### **Claim Rejections-35 USC § 112 and Response to Arguments**

##### *Written Description*

Claims 13-24 and 26-30 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/ or use the invention.

Claims 13-24 and 26-30 are drawn to a trailing interspecific impatiens plant by crossing *Impatiens flaccida* with *Impatiens hawkeri* and its progeny. However, the specification only discloses the crossing of *Impatiens flaccida* with *Impatiens hawkeri* resulting in a progeny with a trailing habit such as 2245B. Applicant argues that specification sufficiently describes how to produce a trailing interspecific impatiens plant that would enable a skilled artisan in the art to which it pertains to make and/or use the invention. This argument is not persuasive because the written description requirement is separate and distinct from the enablement. *In re Barker*,

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559 F.2d 588, 194 USPQ 470 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991). See MPEP 2161.

### **Enablement**

Claims 19-24 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 19 employs novel plants, seeds and plant parts. Since the plants of 2245B are essential to the claimed invention, they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. Applicant argues that the Examiner states that the seeds of 2245B need to be deposited at a recognized depository. This is false because on paper number 20, page 6 it is suggested that the applicant deposit "regenerable tissues of 2245B" not seeds at a recognized depository.

### **2<sup>nd</sup> Paragraph**

The rejection of claims 17-19 and 29 under 35 U.S.C. 112, second paragraph, (paper number 20) is withdrawn in view of Applicant's amendment.

### **Conclusion**

Claim 25 is allowed.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner

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can normally be reached Monday through Friday from 6:30 a.m. to 4:00 p.m. and off alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service Center whose telephone number is (703) 308-0198.

JH



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